UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,261	05/25/2001	Michihiro Hazumi	Q64716	3205

7590 05/04/2006

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER	
GOTTSCHALK, MARTIN A	
ART UNIT	**PAPER NUMBER**
3626	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/864,261	HAZUMI, MICHIHIRO	
	Examiner	Art Unit	
	Martin A. Gottschalk	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 May 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: This is a supplemental action to include claim 1 (see Interview Summary).

DETAILED ACTION

1. Claims 1-28 have been examined.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

A. In the case of the present abstract, it exceeds 150 words and repeats information provided in the title.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-17 and 22-26 are rejected under 35 U.S.C. 102 (b) as being anticipated by Ross et al (US Pat# 5,823,948, hereinafter Ross).

A. As per claim 1, Ross discloses an electronic medical record information management system, comprising:

an electronic medical record information managing means (Ross: col 4, lns 52-53; Fig 1);

and

an electronic medical record showing means (Ross: Fig 1, item 12; col 8, lns 12-25),

wherein:

said electronic medical record information managing means

stores electronic medical records of patients that are transmitted from said electronic medical record showing means every patient (Ross: col 5, lns 53-60),

and

transmits one or more of said electronic medical records of said patients storing in said electronic medical record information managing means by a request transmitted from said electronic medical record showing means to said electronic medical record showing means (Ross: col 5, lns 53-60),

and

said electronic medical record showing means

transmits electronic medical records of patients that are made by a user to said electronic medical record information managing means (Ross: col 5, lns 53-60),

and

transmits a request of said user

to transmit one or more of said electronic medical records of said patients to said electronic medical

record information managing means (Ross: col 6, lns 2-10.),

and

shows one or more of said electronic medical records of said patients transmitted from said electronic medical record information managing means to said user (Ross: col 8, lns 12-25).

B. As per claim 2, Ross discloses an electronic medical record information management system (Ross: col 4, lns 52-53), comprising:

at least one of an electronic medical record information managing means;

plural electronic medical record showing means;

and

a communication network that connects at least one of said electronic medical record information managing means to said plural electronic medical record showing means (Ross: Fig. 1), wherein:

each of

said plural electronic medical record showing means, comprising:

a first communication unit for connecting to said communication network (Ross: Fig. 1, in particular the lines connecting items 7 and 9);

and

at least one of a first electronic medical record terminal (Ross: Fig. 1, items 9 and 10) that

makes electronic medical records of patients and transmits said electronic medical records of said patients to said electronic medical record information managing means through said first communication unit and said communication network (Ross: col 5, lns 53 – 60),

and

makes a request of a user to transmit one or more of said electronic medical records of said patients storing in

said electronic medical record information managing means, and transmits said request to said electronic medical record information managing means through said first communication unit (Ross: col 7, lns 5 – 16, Fig. 2, items 102-103),

and

shows one or more of said electronic medical records transmitted from said electronic medical record information managing means to said user (Ross: col 5, lns 56 – 60),

and

said electronic medical record information managing means, comprising:

a second communication unit for connecting to said communication network (Ross: item 8 in particular, note that it connects items 3 and 7);

an electronic medical record storing server that stores said electronic medical records of said patients that were transmitted

from said electronic medical record showing means (Ross: col 5, ln 66 to col 6, ln 3);

and

a control server (Ross: col 5, lns 22-24; Fig. 1, item 2, reads on Master Server) that obtains one or more of said electronic medical records storing in said electronic medical record storing server by said request of said user transmitted from said electronic medical record showing means, and transmits obtained one or more of said electronic medical records to said electronic medical record showing means through said second communication unit (Ross: col 4, lns 52-59; col 6, lns 3-10).

C. As per claim 4, it is rejected on the same basis as claim 2 above as per the teachings of Ross, with the following exceptions:

an electronic medical record information management system, comprising

each of

said plural electronic medical record showing means, comprising:

an electronic medical record temporarily storing server that stores electronic medical records temporarily and transmits said electronic medical records to said electronic medical record information managing means through said first communication unit and receives electronic medical records from said electronic medical record information managing means through said first communication unit and stores received said electronic medical records temporarily;

and

at least one of a second electronic medical record terminal that makes electronic medical records of patients and transmits said electronic medical records of said patients to said electronic medical record temporarily server, and makes a request of a user to transmit one or more of said electronic medical records of said patients storing in said electronic medical record temporarily storing server, and transmits said request to said electronic medical record temporarily storing server, and shows one or more of said electronic medical records transmitted from said electronic medical record temporarily storing server to said user (Ross: col 5, lns 2-10. The Examiner considers the "storage bin in the communication server to be a form of temporary storage server; Fig. 1, lines

connecting items 24 and 25 with item 4, shows the communication unit means), wherein:

said electronic medical record temporarily storing server searches one or more of said electronic medical records requested by said second electronic medical record terminal in said electronic medical record temporarily storing server,

and

when one or more of said electronic medical records requested by said second electronic medical record terminal are not stored in said electronic medical record temporarily storing server, said electronic medical record temporarily storing server transmits said request to said electronic medical record information managing means through said first communication unit,

and

transmits one or more of said electronic medical records received from said electronic medical record information managing means through said first communication unit to said second electronic medical record terminal.

However, Ross also discloses these features. Ross teaches the use of peripheral storage devices associated with the referenced terminals (Ross: col 4, lns 60-65, note the mention of "hard disks", reads on temporary storage server). A user reads patient files sent from the managing means (Ross: col 5, lns 34-37, reads on "file servers") and if dictated portions of a patient record are not there, they are received at the terminal from the managing means via a "communications server" (Ross: col 5, lns 40-52).

D. As per claims 3 and 5 Ross discloses an electronic medical record information management system in accordance with claim 2, wherein:

said first electronic medical record terminal further

> adds some information to each of said electronic medical records and transmits said electronic medical records added some information to said electronic medical record information managing means through said first communication unit, and said control server further makes said electronic medical record storing server store said electronic medical records received from said electronic medical record showing means through said second communication unit (Ross: col 5, ln 66 to col 6, ln 3).

E. As per claim 6, Ross discloses an electronic medical record information management system in accordance with claim 5, wherein:

> said electronic medical record temporarily storing server stores said electronic medical records until said electronic medical record information managing means stores said electronic medical records (As per the rejection for claim 4, the Examiner considers the files held at the disk drives to be in storage at least until they are stored on the file servers.).

F. As per claim 7, Ross discloses an electronic medical record information management system in accordance with claim 5, wherein:

> said control server makes said electronic medical record showing means delete said electronic medical records storing in said electronic medical record showing means after said electronic medical records were stored in said electronic medical record storing server (Ross: col 5, lns 53-56).

G. As per claims 8 and 9, Ross discloses an electronic medical record information management system in accordance with claim 2, wherein:

> said control server judges whether said user who transmitted said request is a user who has a first access right or not, and when said user has said first access right, said control server obtains said electronic medical record

of said patient designated by said request from said electronic medical record storing server (Ross: Fig. 2, item 101; col 6, section 101 "Security Validation Module"; col 3, lns 33 - 43).

H. As per claims 10 and 11, Ross discloses an electronic medical record information management system in accordance with claim 8, wherein: said electronic medical record showing means, further comprising:

a first access right information making unit that transmits first access right information with which said control server judges whether said user has said first access right or not to said electronic medical record information managing means through said first communication unit, wherein: said control server judges whether said user who transmitted said request is said user who has said first access right or not, based on said first access right information received from said electronic medical record showing means through said second communication unit (Ross: Fig. 2, item 101; col 6, section 101 "Security Validation Module").

I. As per claim 12 and 13, Ross discloses an electronic medical record information management system in accordance with claim 3, wherein:

said control server judges whether said user who transmitted said request is a user who has a second access right or not, and when said user has

said second access right, said control server makes said electronic medical record storing server store said electronic medical records (Ross: Fig. 2, item 101; col 6, section 101 "Security Validation Module", note the variety of methods described by which personnel can demonstrate their identity. Note further the restrictions on types of information different types of personnel are allowed to store on the system, for example, physicians can write prescriptions, but clerks can only enter demographic information. In this example, the Examiner considers that the physician has a second access right with respect to the clerk).

J. As per claims 14 and 15, Ross discloses an electronic medical record information management system in accordance with claim 12, wherein:

said electronic medical record showing means, further comprising:

a second access right information making unit that transmits second access right information with which said control server judges whether said user has said second access right or not to said electronic medical record information managing means through said first communication unit, wherein:

said control server judges whether said user who transmitted said request is said user who has said second access right

or not, based on said second access right information received from said electronic medical record showing means through said second communication unit (Ross: Fig. 2, item 101; col 6, section 101 "Security Validation Module". The Examiner considers all access rights are processed -by the same functional unit, i.e. the "Security Validation Module".).

K. As per claim 16 and 17, Ross discloses an electronic medical record information management system in accordance with claim 2, wherein:

said electronic medical record includes original data before new data are added (Ross: col 7, lns 18 – 31. The Examiner considers the existence of an "Historical medical record" to indicate the presence of original data prior to the addition of data from "new visits".).

L. As per claims 22-26 they are method claims which repeat the same limitations of claims 2, 8, (5, 6, and 7 for claim 24), 12, and 16 respectively, the corresponding system claims, as a series of process steps as opposed to a collection of elements. Since the teachings of Ross disclose the structural elements that constitute the system of claims 2, 8, (5, 6, and 7 for claim 24), 12, and 16 respectively, it is respectfully submitted that they perform the underlying process steps, as well. As such, the limitations of claims 22-26 are rejected for

the same reasons given above for claims 2, 8, (5, 6, and 7 for claim 24), 12, and 16 respectively.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 18, 19, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross as applied to claim 2 above, and further in view of Wallace et al (US Pat# 6,564,121, hereinafter Wallace).

A. As per claims 18 and 19 Ross fails to explicitly disclose an electronic medical record information management system in accordance with claim 2, wherein:

when data are transmitted between said electronic medical record information managing means and said electronic medical record showing means,

said data are encrypted and said encrypted data are transmitted, and when data are received at said electronic medical record information managing means and said electronic medical record showing means, said data are decrypted.

However, these features are well in the art as evidenced by the teachings of Wallace.

Wallace teaches dispensing medical products over a networked communications system (Wallace: Abstract), with patient medical data that is encrypted locally and decrypted at a remote location (Wallace: col 16, lns 22-32; Fig. 9B, items 522 and 508).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the use of data encryption/decryption taught by Wallace into the system of Ross with the motivation of better preserving the confidentiality of patient information as it is transmitted over a network (Wallace: col 2, lns 30-35).

B. As per claim 28 it is a method claim which repeats the same limitations of claim 18, the corresponding system claim, as a series of process steps as opposed to a collection of elements. Since the collective teachings of Ross and Wallace disclose the structural elements that constitute the system of claim 18, it is respectfully submitted that they perform the underlying process steps, as well. As such, the limitations of claim 28 are rejected for the same reasons given above for claim 18.

The motivation for incorporating the features of Ross and Wallace is as given above in the rejection of claim 18, and is incorporated herein.

8. Claims 20, 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross as applied to claim 2 above, and further in view of Olsen et al (US PG Pub# 2002/0016921, hereinafter Olsen).

A. As per claims 20 and 21 Ross fails to disclose an electronic medical record information management system in accordance with claim 2, wherein:

said electronic medical record information managing means, further comprising:

a charging server that calculates a using charge of said electronic medical record information managing means by each of said plural electronic medical record showing means and charges said using charge to each of said plural electronic medical record showing means.

However, this feature is well known in the art as evidenced by the teachings of Olsen.

Olsen teaches a server that monitors the use of a printer/viewer system by counting printed pages in order to charge the user for the printing (or viewing) of a document (Olsen: [0069]; Fig. 2, item 134; [0108]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the charging server taught by Olsen with the teachings of Ross with the motivation of allowing a user to monitor the status of an account with respect to either balance of charges accrued or credit remaining on a pre-paid account (Olsen: [0069], next to last sentence).

B. As per claim 27 it is a method claim which repeats the same limitations of claim 20, the corresponding system claim, as a series of process steps as opposed to a collection of elements. Since the collective teachings of Ross and Olsen disclose the structural elements that constitute the system of claim 20, it is

respectfully submitted that they perform the underlying process steps, as well. As such, the limitations of claim 27 are rejected for the same reasons given above for claim 20.

The motivation for incorporating the features of Ross and Olsen is as given above in the rejection of claim 18, and is incorporated herein.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art discloses systems and methods for the management of medical records (US Pat#s 5,065,315, 5,659,741, 6,024,699) and the use of temporary storage devices (US Pat# 5,535,322).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MG
04/17/2006

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER